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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,658	10/06/2003	Michael S. Boulineau	10-9429	5796
37374	7590	11/09/2004	EXAMINER	
INSKEEP INTELLECTUAL PROPERTY GROUP, INC			STULTZ, JESSICA T	
1225 W. 190TH STREET			ART UNIT	
SUITE 205			PAPER NUMBER	
GARDENA, CA 90248			2873	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,658

Applicant(s)

BOULINEAU ET AL.

Examiner

Jessica T Stultz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152:

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0704</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Specifically, on page 3, section 14 of the specification, applicant refers to numerous Japanese applications and incorporates them by reference. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9, 11-14, 22, 24, 26-30, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Farwig (Figure 4).

Regarding claim 1, Farwig (Figure 4) discloses an optical element (Column 8, lines 16-28, wherein the optical element is “1”, Figure 4) comprising: a first layer having a first size (Column 8, lines 16-28, wherein the first layer is single lens body “10”, Figure 4); a second, functional layer having a second size (Column 8, lines 16-28, wherein the second, functional layer is polarizing coating “9”, Figure 4); the second, functional layer disposed adjacent to said first layer (Shown in Figure 4, wherein the second layer “9” is adjacent to the first layer “10”); and wherein the second size is smaller than the first size (Shown in Figure 4, wherein the size of the second layer “9” is smaller than the size of the first layer “10”).

Regarding claim 2, Farwig (Figure 4) further discloses that the second size has a diameter that is smaller than the diameter of the first size (Shown in Figure 4, wherein the diameter of the second layer “9” is smaller than the diameter of the first layer “10”).

Regarding claim 4, Farwig (Figure 4) further discloses that the second functional layer is a polarizing layer (Column 8, lines 16-28, wherein the second layer “9” is a polarizing coating, Figure 4).

Regarding claims 5-6, Farwig (Figure 4) further discloses that the first layer is a functional layer, specifically a color management layer (Column 8, lines 16-28, wherein the first layer “10” is a trichroic contrast enhancer, Figure 4).

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Regarding claim 7, Farwig (Figure 4) further discloses that the first layer is a coloring layer (Column 8, lines 16-28, wherein the first layer “10” is a trichroic contrast enhancer, Figure 4).

Regarding claim 9, Farwig (Figure 4) further discloses a third layer disposed adjacent the second, functional layer, the third layer having a third size (Column 8, lines 16-28, wherein the third layer is “6”, Figure 4).

Regarding claim 11, Farwig (Figure 4) further discloses that the third size has a diameter that is substantially equal to a diameter of the second size (Shown in Figure 4, wherein the third layer “6” has a diameter that is the same size diameter as the second layer “9”).

Regarding claim 12, Farwig (Figure 4) further discloses that the second functional layer is a polarizing layer (Column 8, lines 16-28, wherein the second layer “9” is a polarizing coating, Figure 4).

Regarding claims 13-14, Farwig (Figure 4) further discloses that the first layer is a functional layer, specifically a color management layer (Column 8, lines 16-28, wherein the first layer “10” is a trichroic contrast enhancer, Figure 4).

Regarding claim 22, Farwig (Figure 4) discloses a method of making an optical element (Column 8, lines 16-28, wherein the optical element is “1”, Figure 4) comprising: providing a first layer (Column 8, lines 16-28, wherein the first layer is “10”, Figure 4); providing a second layer substance, the second layer substance being functional (Column 8, lines 16-28, wherein the second, functional layer is polarizing coating “9”, Figure 4); configuring said second layer functional substance against the first layer (Shown in Figure 4, wherein the second layer “9” is adjacent to the first layer “10”); such that a size of the second layer functional substance is less

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than a size of the first layer (Shown in Figure 4, wherein the size of the second layer “9” is smaller than the size of the first layer “10”).

Regarding claim 24, Farwig (Figure 4) further discloses applying a third layer against the second layer substance (Column 8, lines 16-28, wherein the third layer is “6”, Figure 4).

Regarding claim 26, Farwig (Figure 4) further discloses that the step of providing a second layer functional substance includes providing a polarizing layer (Column 8, lines 16-28, wherein the second layer “9” is a polarizing coating, Figure 4).

Regarding claims 27-28, Farwig (Figure 4) further disclose that the step of providing a first layer includes providing a first layer functional substance, specifically a coloring layer (Column 8, lines 16-28, wherein the first layer “10” is a trichroic contrast enhancer, Figure 4).

Regarding claim 29, Farwig (Figure 4) further discloses that the step of configuring the second functional substance includes sizing a diameter of the second layer functional substance to be less than a diameter of the first layer (Shown in Figure 4, wherein the diameter of the second layer “9” is smaller than the diameter of the first layer “10”).

Regarding claims 3 and 30, Farwig (Figure 4) discloses an optical element and method of making an optical element as shown above, but does not specifically disclose that the second size diameter is less than the first size diameter within a range of approximately 0.5 mm to 5 mm. However, it is inherent that the second layer to have a diameter less than the first size diameter within a range of approximately 0.5 mm to 5 mm due to the similarity in structure between the prior art and the claimed invention (Figure 5), wherein the difference in the diameters of the layers is very small, and based on what is disclosed as the thickness of one of the layers (Column 5, lines 43-62, wherein the rear layer “4” is disclosed as having a thickness of 1 mm, so the

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diameter difference shown in Figure 4 is apparently within the claimed range) and based upon the large range that is claimed.

Regarding claim 32, Farwig (Figure 4) discloses an optical element (Column 8, lines 16-28, wherein the optical element is "1", Figure 4) comprising: a first layer having a first size (Column 8, lines 16-28, wherein the first layer is "10", Figure 4); a second layer having a second size (Column 8, lines 16-28, wherein the second, functional layer is polarizing coating "9", Figure 4); the second layer disposed adjacent to the first layer (Shown in Figure 4, wherein the second layer "9" is adjacent to the first layer "10"); and wherein the second size is smaller than the first size (Shown in Figure 4, wherein the size of the second layer "9" is smaller than the size of the first layer "10").

Regarding claim 33, Farwig (Figure 4) further discloses that the first layer is a functional layer (Column 8, lines 16-28, wherein the first layer "10" is a trichroic contrast enhancer, Figure 4).

Regarding claim 34, Farwig (Figure 4) further discloses that the second layer is a functional layer (Column 8, lines 16-28, wherein the second, functional layer is polarizing coating "9", Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farwig (Figure 4) in view of Farwig (Figure 2).

Regarding claim 10, Farwig (Figure 4) discloses an optical element as shown above, but does not specifically disclose that third size diameter is the same as the first size diameter. However, Farwig (Figure 2) further teaches of a double lens element, having a first layer, second layer, and third layer, wherein the third layer has the same diameter as the first layer for the purpose of providing durability for the front lens element (Column 6, lines 42-56, wherein the first layer is "4", the second layer is "3" and the third layer is "5", Figure 2). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the optical element of Farwig (Figure 4) to further include the third size diameter being the same as the first size diameter since Farwig (Figure 2) further teaches of a double lens element, having a first layer, second layer, and third layer, wherein the third layer has the same diameter as the first layer for the purpose of providing durability for the front lens element.

Claims 8, 15-21, 23, 25, 31, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farwig (Figure 4) in view of Robran et al.

Regarding claim 8 and 15, Farwig (Figure 4) discloses an optical element as shown above, but does not specifically disclose that the first and third layers are resinous layers. Robran et al teaches of plastic lens wherein the lens material is made of resin for the purpose of providing a high contrast resolution lens (Column 5, line 22-Column 6, line 42, wherein the lens material is "24", Figure 1). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the first and third layers to be resinous layers since

Robran et al teaches of plastic lens wherein the lens material is made of resin for the purpose of providing a high contrast resolution lens.

Regarding claims 16-21, 23, 25, 31, and 35-36, Farwig (Figure 4) discloses an optical element and method of making an optical element as shown above, but does not specifically disclose an injection molded substance, specifically a polycarbonate, being injected adjacent the lens, wherein the lens and molded material are comprised of the same material. Robran et al teaches of an optical element wherein an injection molded substance, specifically polycarbonate, is injected around the outside of the lens, wherein the lens and molded material are comprised of the same material for the purpose of providing a molded pliable frame around the lens (Column 3, lines 3-10, and Column 4, lines 45-51, wherein the frame "22" is injection molded as one piece from polycarbonate around the polycarbonate lens "24", Figure 2). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the optical element and method of making an optical element of Farwig (Figure 4) to further include an injection molded substance, specifically a polycarbonate, being injected adjacent the lens, wherein the lens and molded material are comprised of the same material since Robran et al teaches of an optical element wherein an injection molded substance, specifically polycarbonate, is injected around the outside of the lens, wherein the lens and molded material are comprised of the same material for the purpose of providing a molded pliable frame around the lens.

Conclusion

For applicant's information, based upon the broadness of the claims, particularly the independent claims, numerous references would have read on or made obvious these claims, however such rejections would have been repetitious. For example US 6,328,446, listed on the

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IDS would have at least read on the independent claims as shown in Figure 2, wherein layer "12" is the first layer and layer "14" is the second functional layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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October 2, 2004



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